

**Section III (Amendments to the Drawings)**

Please amend the drawings by substituting the enclosed replacement drawing sheets 1-3 (inclusive of Figures 1-3) for drawing sheets 1-3 as originally filed.

**Section IV (Remarks)****A. Summary of Amendments**

By the present amendment, claims 10, 17, 23, and 56 have been amended; the second paragraphs of each of pages 7 and 8 of the specification have been amended; and replacement drawing sheets 1-3 have been substituted for the corresponding drawing sheets 1-3 as originally filed. No new matter within the meaning of 35 U.S.C. 132 has been introduced by the foregoing amendments.

**B. Drawing Objections**

In the November 15, 2006 Office Action, the drawings were objected to under 37 CFR 1.83(a) as failing to show the frequency indicator and frequency tuning control as recited in independent claims 1, 17, and 52.

Replacement drawing sheets 1-3 are submitted herewith in response to such objections. Element numbers 17A, 17B and corresponding lead lines have been added to identify control elements (e.g., inclusive of a frequency tuning control) pictured in the originally-filed Figures 1-3. Illustration of a frequency indicator 19 has been added to Figures 1-3 consistent with the recitation of such frequency indicator in the specification as originally filed. Element number 11 and a corresponding lead line has also been added to identify the body of the audio player 12 as depicted in the original drawing sheets.

Corresponding to such drawing amendments, the specification has been amended by the addition of one phrase to page 7 and two sentences to page 8, i.e., to provide text corresponding to element numbers 11 (body), 17A-17B (control elements), and 19 (frequency indicator). No new matter within the meaning of 35 U.S.C. 132 has been introduced by any of the amendments made herewith.

With the submission of replacement sheets 1-3 depicting the frequency indicator and frequency tuning control, the drawing objections under 37 CFR 1.83(a) should be withdrawn. Withdrawal of such objections is respectfully requested.

C. Claim Rejections Under 35 U.S.C. 112

In the November 15, 2006 Office Action, claims 10, 23, and 56 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement since the original specification purportedly fails to disclose an IEEE 1394-compliant coupling.

Applicant disagrees with the 112 rejection in that Firewire (as originally recited) is one example of an IEEE 1394-compliant coupling, but for the sake of avoiding further conflict and promoting rapid allowance of the application, claims 10, 23, and 56 have been amended to remove any recitation of an IEEE 1394-compliant coupling.

In view of these amendments, the claim rejections under 35 U.S.C. 112 should be withdrawn, and withdrawal of such rejections is respectfully requested.

D. Claim Rejections Under 35 U.S.C. 103(a)

In the November 15, 2006 Office Action, claims 52-68 were rejected for obviousness on various prior art grounds, namely:

- Claims 52-60 and 62-68 were rejected under 35 U.S.C. 103(a) as being unpatentable for obviousness over U.S. Patent Application Publication No. 2004/0224638 to Fadell ("Fadell") in view of U.S. Patent Application Publication No. 2002/0002039 to Qureshey ("Qureshey"); and
- Claim 61 was rejected under 35 U.S.C. 103(a) as being unpatentable for obviousness over Fadell and Qureshey as applied to claim 52, and further in view of U.S. Patent Application Publication No. 2002/0086703 to Dimenstein ("Dimenstein").

Such rejections are traversed, as detailed below.

## 1. Law Regarding Obviousness Rejections

Concerning § 103 obviousness rejections, three requirements must be met for a *prima facie* case of obviousness. First the prior art reference(s) must teach all of the limitations of the claims. M.P.E.P. § 2143.03. Second, there must be a motivation to modify the reference or combine the teachings to produce the claimed invention. M.P.E.P. § 2143.01. Third, a reasonable expectation of success is required. M.P.E.P. § 2143.02.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143. It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements. *Arkie Lures, Inc., v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957 (Fed. Cir. 1997). The fact that references could conceivably be modified or combined is insufficient to meet this criterion. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453 (Fed. Cir. 1998); *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430 (Fed. Cir. 1990).

A *prima facie* case of obviousness can be rebutted, *inter alia*, by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997), citing *In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974).

## 2. Discussion of Examiner Note Regarding Modular Docking Unit

At paragraph 5 of the November 15, 2006 Office Action, the examiner stated:

It is noted that independent claim 52 does not clearly recite that it is the modular docking unit which comprises a frequency indicator and a frequency tuning control as in independent claims 1 and 17. Therefore, claim 52 is not allowed as claims 1 and 17.

Applicant notes that claim 52 recites a “main body portion having a docking cavity .... [and a] **frequency indicator disposed on the main body portion and a frequency tuning control**”

**disposed on the main body portion,”** with claims 1 and 17 reciting the “a modular docking unit having a main body portion with a docking cavity... [with] any of **a frequency indicator on the main body portion and a frequency tuning control on the main body portion.**” The similarity of claims 52, 1, and 17 in this regard is unmistakable.

Clearly, as to ALL of claims 1, 17, and 52, the frequency tuning control and/or frequency indicator **must** be on (e.g., disposed on) the same “main body portion” in which the docking cavity is defined. **Whether the frequency tuning control and/or frequency indicator portion happens to *also* be disposed on a “modular docking unit,” however, is not essential to the patentability of the claims**, since the prior art fails to teach or suggest in combination the other limitations of the claims.

In other words, the examiner has drawn an arbitrary distinction between claim 52 on the one hand, and claims 1 and 17 on the other; as detailed below, all of these claims should be allowed.

## 2. Disclosure of Fadell

Fadell discloses various embodiments of a media player systems that allow a portable digital media player (e.g., such as an Apple Computer iPod®) to communicate with other media devices. Some embodiments disclose docking stations for establishing contact-type or “wired” communication between a portable digital media player and another device (i.e., via a docking station associated with the other device), while other embodiments disclose portable digital media players having associated wireless transmitters for establishing non-contact or wireless communication between a portable digital media player and another device.

### *a. Fadell Embodiment Requiring a Docking Station*

One embodiment involving **contact-type or wired communication** between a portable digital media player and another device is disclosed in connection with Fadell Fig. 12 (as reproduced below), in which a portable media player 379 is docked to a sound system 370 (having speakers 376) via an integrated docking station 372.

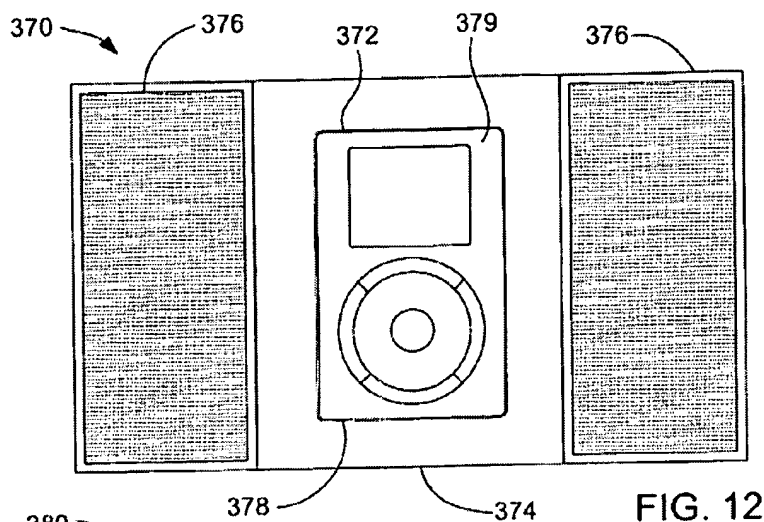


FIG. 12

While the embodiment of Fadell Fig. 12 *does* depict speakers 376 connectable to a portable digital media player via a docking station 372 of a sound system 370, **nothing in Fadell Fig. 12 or its corresponding description remotely suggests that a main body of the sound system 370 should have a radio receiver** (e.g., for receiving FM radio signals) – *let alone incorporate any frequency tuning control or frequency display*. To the contrary, Fadell states that connection is made between the media player 379 and the sound system 370 via the docking station 372. In this regard, Fadell suggests only that digital media stored on the portable digital media player 379 will be conducted through the docking station 372 to the sound system 370 to be played through the speakers 376. The pertinent text (i.e., paragraph [0091]) of Fadell supports this idea, as reproduced below:

[0091] FIG. 12 is front view of a sound system 370 with an integrated docking station 372, in accordance with one embodiment of the present invention. The sound system may be widely varied. For example, it may be a substantially fixed or portable unit. In the illustrated embodiment, the sound system 370 is a flat panel unit that includes a base 374 and a pair of speakers 376. The docking station 372 is integrated within the base 374. The docking station 372 includes a media bay 378 that may be placed anywhere on the base 374, as for example, the sides, top, front, back or bottom surfaces. **The media bay 378 may be configured to receive any surface of a media player 379 so long as a connection is made between the media player 379 and the docking station 372.** For example, it may be configured to receive the back of the media player as shown in FIG. 3 or it may be configured to receive the bottom of the media player as shown in FIG. 4. In the illustrated embodiment, the media bay 378 is configured to receive the back side of the media player 379. In some cases, the user interface of the media player 379 may be the primary user interface of the

sound system 370 and in other cases, the user interface is secondary to a user interface of the sound system 370.

In other words, the embodiment of Fadell Fig. 12 indicates in **mandatory terms** (i.e., “so long as”) that connection or communication between the portable media player 379 and the sound system 370 is made through the docking station 372. No radio receiver is associated with the sound system 370.

*b. Fadell Embodiment Requiring a Wireless Transmitter*

In very different embodiment than that described in connection with Fig. 12, Fadell discloses a “wireless communication system 400” in connection with Fig. 15, in which wireless communication (i.e., without any docking cavity) is established between a portable digital media player 402 (e.g., an Apple Computer iPod®) and one or more media devices 404, as indicated in the following figure and corresponding textual excerpts from Fadell:

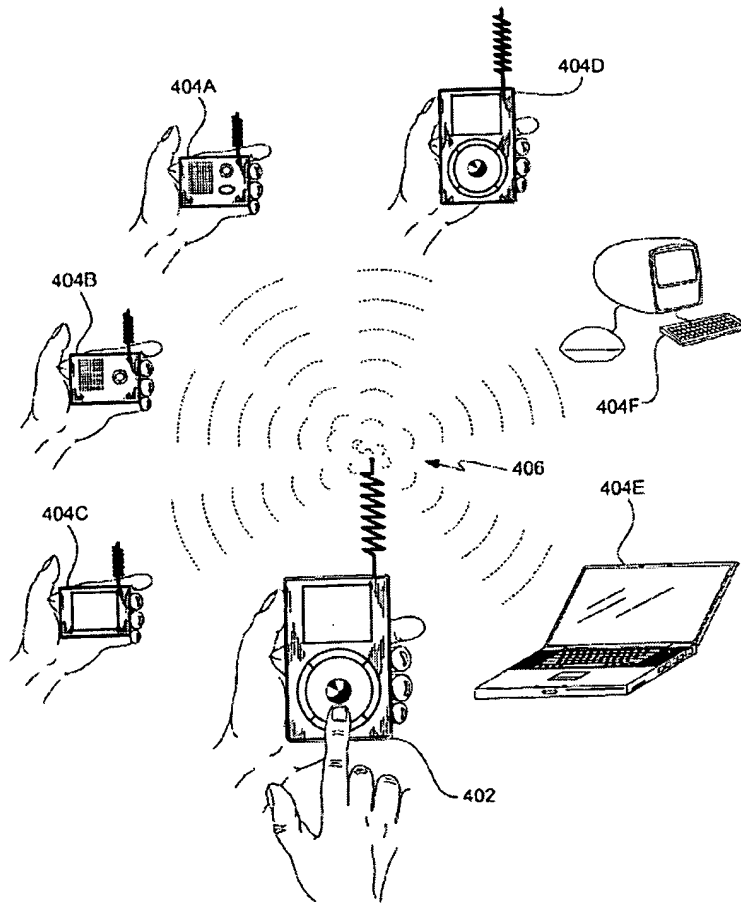


FIG. 15

[0096] FIG. 15 is a diagram of a **wireless communication system 400**, in accordance with one embodiment of the present invention. The wireless communication system 400 generally includes a media player 402 and one or more media devices 404. **The media player 402 is configured to send media via a wireless communication link 406 to the media devices 404** and the media devices 404 are configured to receive the media sent by the media player 402 over the wireless communication link 406. **The media player is essentially configured to act as a personal transmitting station so that the user can transmit media stored on the media player to other devices.** In some cases, the media devices 404 may also send media to the media player 402 and the media player 402 may also receive media from the media devices 404. By way of example, the media may generally correspond to audio, video, images, text and the like.

\* \* \*

[0100] Personal tuning devices 404B generally include a speaker (or headphone jack) and a volume control dial so as to listen to audio based media (e.g., music)



being sent by the media player 402. The **personal tuning devices may also include an antenna and a frequency tuner for selecting which channel to receive and send information. In one embodiment, the personal tuning device 404B corresponds to a radio (e.g., the media player may include an FM transmitter and the radio may include an FM receiver).**

Thus, it is noted that wireless communication via link 406 between the media player 402 and various satellite devices 404A-404F is a central feature of the embodiment of Fadell Figure 15.

*c. Distinctness of Fadell's Wired and Wireless Embodiments*

In a nutshell, Fadell discloses that there are two distinct ways of communicating signals from a portable digital media player (e.g., an Apple Computer iPod®) to an external audio player (e.g., sound system 370 or media devices 404A-404F), namely:

- (1) via contact-type or wired communication through a docking station 372 into which the media player 379 is inserted (e.g., see Fadell Fig. 12 and corresponding text)

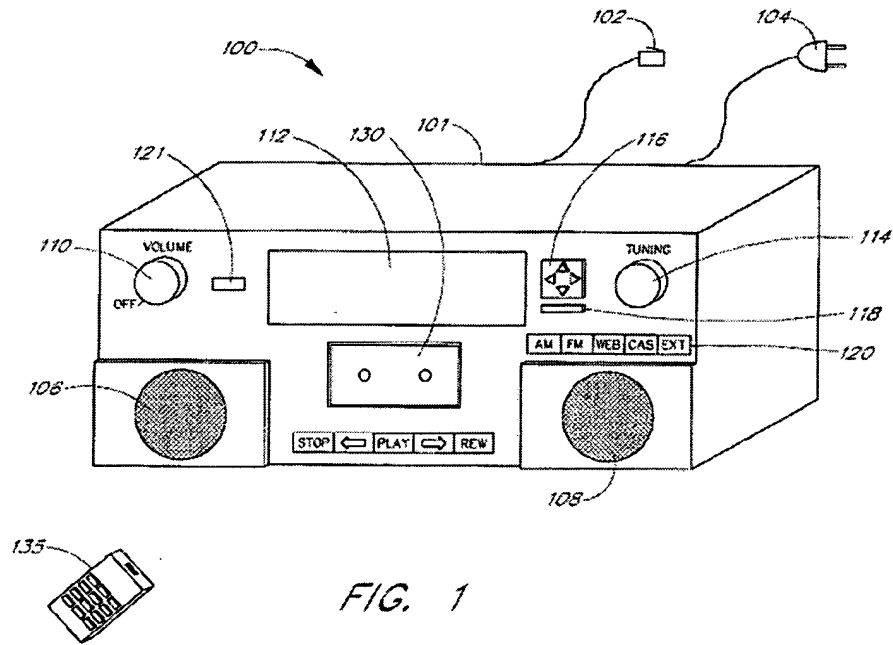
**\* OR \***

- (2) via wireless transmission in which a media player 402 includes a wireless (e.g., FM) transmitter, and a separate media device (e.g., device 404B as illustrated in Fadell Fig. 15) receives wireless signals from the remotely located media player 402.

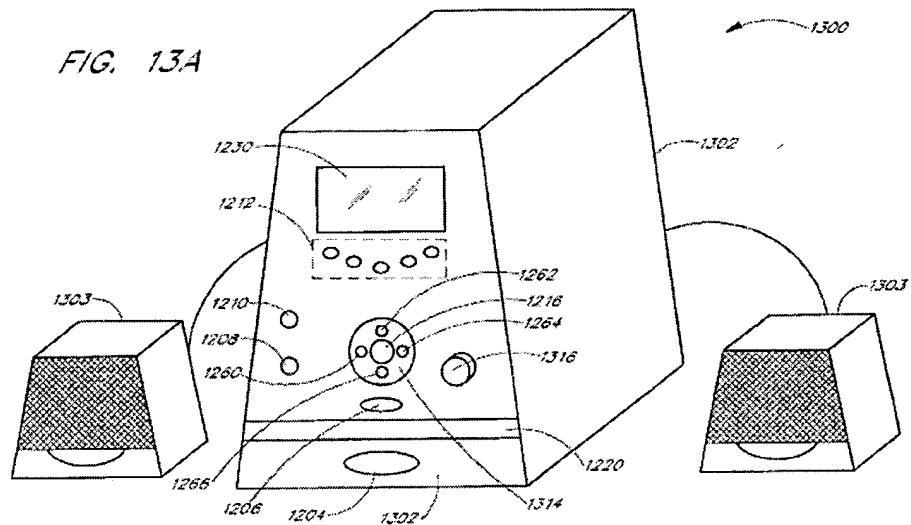
**No embodiments of Fadell disclose both (1) contact-type or wired communication through a docking station, and (2) wireless communication or reception.**

3. Disclosure of Qureshey

Qureshey discloses a network-enabled audio device such as illustrated FIG. 1 thereof, as reproduced below:



In the November 15, 2006 Office Action (at paragraph 7 thereof), the Examiner cited Qureshey as disclosing “an audio player having a main body portion comprising a frequency indicator and a frequency tuning control” such as illustrated in Figures 13A-13B thereof (with Figure 13A illustrated below):



Such embodiments are consistent with conventional stereo receivers, which commonly have a frequency indicator and frequency tuning control. **Nothing in Qureshey, however, teaches or**

suggests any “docking cavity” integrated into the body of an audio player for receiving a portable digital media player. The fact that Qureshey provides a frequency indicator and a frequency tuning control on a main body portion is immaterial to the subject matter of the pending claims because Qureshey fails to teach any docking cavity. Accordingly, Qureshey fails to supply the teachings missing from Fadell necessary to support a rejection of claim 52 or claims depending therefrom.

#### 4. Disclosure of Dimenstein

Dimenstein discloses a mobile computing device docking station including an indicator light indicating the charging status of a battery in a communication device docked thereto. Nothing in Dimenstein, however, teaches or suggests a docking cavity integrated into the body of an audio player having a FM receiver and at least one speaker, and selectively operable with the FM receiver and the portable digital media player. In this regard, Dimenstein fails to supply the teachings missing from Fadell and Qureshey necessary to support a rejection of claim 52 or claims depending therefrom.

#### 5. Patentable Distinctions Between Claim 52 and Any Combination of the Cited References

As noted previously, claim 52 recites:

52. An audio player adapted for use with a portable digital media player having a storage medium adapted to receive and store digital media files, the **audio player comprising:**  
**a main body portion having a docking cavity adapted to receive said portable digital media player**, wherein the docking cavity includes therein an electrical coupling element adapted to engage the portable digital media player when the portable digital media player is received by the docking cavity;  
**an FM receiver having an associated frequency indicator disposed on the main body portion and a frequency tuning control disposed on the main body portion; and**  
**at least one speaker associated with the main body portion and selectively operable with (1) the FM receiver, and (2) the portable digital media player when received by the docking cavity, to output audible signals.**

The system of claim 52 provides various benefits not afforded by the systems described in connection with Fadell, Qureshey, and Dimenstein. Where the FM receiver is adapted to receive broadcast radio signals, then the audio player remains highly functional as a user-controllable radio boombox even when no portable digital media player is docked thereto. Moreover, by providing direct contact-type or “wired” docking between the portable digital media player and the audio player via the docking cavity, high-quality (e.g., substantially noise-free) audible signals may be reproduced through the at least one speaker from digital media signals played by the docked portable digital media player. Potential interference and bandwidth problems associated with wireless transmission are avoided through the use of a docking cavity for signal transfer from the portable digital media player to the speaker-containing audio player.

Nothing in Fadell teaches or suggests **BOTH** a docking station and a radio receiver disposed in the same audio player – *let alone* (A) frequency tuning control and a frequency display element on a main body of the audio player, or (B) at least one speaker selectively operable with an FM receiver and a portable digital media player. That is, even if Fadell were to teach a docking station and radio receiver disposed in the same main body of an audio player, which it does not, Fadell still fails to teach features (A) and (B) as identified immediately above.

The fact that Fadell *separately* discloses a docking cavity disposed in an audio player according to one embodiment (e.g., in connection with Figure 12) and a wireless receiver disposed in an audio player according to another embodiment (e.g., in connection with Figure 15) is unavailing under Federal Circuit precedent to support a rejection of claim 52.<sup>1</sup>

Qureshey was cited by the Examiner relative to claim 52 as disclosing an audio player having a main body portion comprising a frequency indicator and a frequency tuning control. However, **nothing in Qureshey recites any “docking cavity adapted to receive a portable digital media**

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<sup>1</sup> See, e.g., *Arkie Lures, Inc., v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957 (Fed. Cir. 1997) (It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements.); *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453 (Fed. Cir. 1998); *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430 (Fed. Cir. 1990) (The fact that references could conceivably be modified or combined is insufficient to meet this criterion).

**player”** or remedies the other above-identified multiple deficiencies in the disclosure of Fadell relative to the subject matter of claim 52.

Dimenstein was cited by the Examiner relative to claim 61 as disclosing an indicator light indicating the charging status of a device docked in a docking unit. While Dimenstein discloses an indicator light indicating charging status, it fails to remedy the above-identified multiple deficiencies in the disclosures of Fadell and Qureshey relative to the subject matter of claim 52.

No motivation to combine a docking cavity and a FM receiver in an audio player has been demonstrated in the record aside from Applicant’s disclosure – *let alone* motivation to provide a frequency indicator and a frequency tuning control disposed on the main body portion, or provide at least one speaker selectively operable with an FM receiver and a portable digital media player. **The Federal Circuit has repeatedly pronounced that relying upon Applicant’s disclosure to support a suggestion to modify prior art is impermissible.** See, e.g., *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) (“To imbue one of ordinary skill in the art with the knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.”)

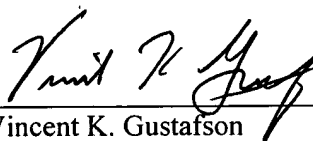
Since Fadell, Qureshey, and Dimenstein, whether separately or combined, fail to teach all of the limitations of claim 52 (or the claims depending therefrom, which inherently include all the limitations of claim 52), no *prima facie* case of obviousness has been demonstrated pursuant to M.P.E.P. § 2143.03. Accordingly, the obviousness rejections of claims 52-60 and 62-68 cannot stand, and should be withdrawn. Withdrawal of such rejections and issuance of a Notice of Allowance on all pending claims is respectfully requested.

**CONCLUSION**

Claims 1, 3-6, 8-11, 14-24, 27, and 29-68 as provided herein are fully distinguished over the cited references, and are in form and condition for allowance. Issue of a Notice of Allowance without delay for the application is therefore requested.

If any issues remain outstanding, incident to the formal allowance of the application, the Examiner is requested to contact the undersigned attorney at (919) 419-9350 to discuss same, in order that this application may be allowed and passed to issue at an early date.

Respectfully submitted,



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**Enclosures:**

Replacement Drawing Sheets 1-3 [3 pages]  
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